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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/220,962	12/28/1998	BRIAN CRUICKSHANK	81749-2	5390

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EXAMINER

SING, SIMON P

ART UNIT	PAPER NUMBER
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2645

DATE MAILED: 05/07/2004

20

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/220,962

Applicant(s)

CRUICKSHANK ET AL.

Examiner

Simon Sing

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _____ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 February 2004.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-77 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 5-28, 31-34, 36-46, 48-54, 56, 57, 60-69 and 71-76 is/are rejected.
- 7) ☒ Claim(s) 3, 4, 29, 30, 35, 47, 55, 58, 59, 70 and 77 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date, _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Objections

1. Claim 29 is objected to because of the following informalities: Line 3 contains a typo: "... information signal to 5 a web page...". The numeral 5 should be deleted. Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

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2. Claims 1, 2, 5-12, 16, 21-23, 31, 32, 34, 36-46, 50-54, 56, 57, 60-64, 66, 67, 71 and 73 are rejected under 35 U.S.C. 102(e) as being anticipated by Dawson US 6,252,588.

2.1 Regarding claims 1, 34, 56 and 73, Dawson discloses a method and apparatus for providing an audio-visual e-mail system. Dawson teaches that in incoming e-mail notifications, standard e-mail addresses of senders are replaced by thumbnail pictures of the senders (column 9, lines 41-52; column 30, lines 42-46). Dawson teaches generating an information signal by extracting a sender's thumbnail picture (by an e-mail server) from an e-mail message's header, relating a stored e-mail message to a sender's (source) graphical image (thumbnail picture of the sender) and transmitting the information signal (thumbnail picture) to a recipient's e-mail apparatus (communication device) for indicating receipt of the stored e-mail message (Figure 10; column 9, lines 49-52; column 16, lines 56-67; column 30, lines 42-46).

2.2 Regarding claims 2, 16, 44, 45 and 57, as discussed above, Dawson teaches including a sender's picture in the information signal.

2.3 Regarding claims 5, 31 and 60, Dawson teaches transmitting the information signal to a recipient's e-mail apparatus by the e-mail server (Figure 10; column 9, lines 49-52; column 16, lines 56-67; column 30, lines 42-46).

2.4 Regarding claim 6, Dawson teaches receiving a sender's thumbnail picture as a notification signal that the stored e-mail message has been received.

2.5 Regarding claim 7, the information signal (sender's thumbnail picture) is stored in the e-mail server for subsequent retrieval and transmission to a recipient's communication device (Figure 10; column 9, lines 49-52; column 30, lines 42-46).

2.6 Regarding claim 8, the information signal is generated after a message has been received (Figure 10; column 9, lines 49-52; column 30, lines 42-46).

2.7 Regarding claims 9, 10, 62 and 63, Dawson teaches determining the source of a message (sender's thumbnail picture) (figure 10).

2.8 Regarding claims 11 and 64, it is inherent that the email server determines the e-mail address of the source of the stored message, such as sending an error message to the sender if an e-mail cannot be delivered or sending a replay message to the sender.

2.9 regarding claim 12, Dawson teaches requesting source information (sender's thumbnail picture) from a sender's communication device, which is also a networked device since it is connected to a network for sending and receiving e-mails, to be sent with an e-mail, the source information is associated with at least one graphical image (column 9, lines 49-52; column 30, lines 42-46).

2.10 Regarding claims 21, 43 and 66, Dawson teaches transmitting the stored e-mail message, including a voice message to the addressee upon request (column 16, lines 56-67; column 17, lines 9-16, 55-63).

2.11 Regarding claims 22, 50 and 67, it is inherent that the information signal is transmitted to recipient's communication device when the communication device logged on (request for pending notification) to the e-mail server.

2.12 Regarding claim 23, Dawson teaches a sender keeps a database of thumbnail pictures of recipients (column 15, lines 5-15).

2.13 Regarding claims 32 and 71, Dawson teaches that the sender pre-selects the thumbnail picture (column 13, lines 1-6, 13-18).

2.14 Regarding claim 36, Dawson teaches that sending the information signal (sender's thumbnail picture) by an e-mail server (notification server).

2.15 Regarding claims 37 and 61, it is inherent that the information signal is stored in an e-mail server.

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2.16 Regarding claim 38, it is inherent that an e-mail server (computer server) communicates with a network resource (sender's communication device).

2.17 Regarding claim 39, it is inherent that a transmitter within the e-mail server (computer server) transmits the information signal to a recipient's communication device.

2.18 Regarding claims 40 and 41, it is inherent that an e-mail server has a receiver for receiving a request (recipient logged onto the server) receiving a notification.

2.19 Regarding claim 42, it is inherent that a transmitter within an e-mail server transmits the information signal (thumbnail picture) to a recipient's communication device.

2.20 Regarding claim 46, Dawson teaches that an e-mail server retrieves a sender's thumbnail picture from an e-mail message received (Figure 10).

2.21 Regarding claims 51-54, Dawson teaches that a recipient's communication device is programmed to communication with an e-mail server (network computer) and to receive and display the sender's thumbnail picture (Figure 10).

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3. Claim 73 is rejected under 35 U.S.C. 102(e) as being anticipated by Yue et al. US 5,937,050.

Yue discloses a method for identifying the source of a stored message. Yue teaches that a user has option when accessing a voice messaging system in figure 13A and 13B. Yue teaches that when the user chooses to listen to voice mail envelope information, the voice messaging system generating an information signal (playing caller's name (step 285) and telephone number (step 286)) to (transmitting) the user (addressee) via a user telephone (communication device), for indicating receipt of a voice message.

4. Claims 73 and 75 are rejected under 35 U.S.C. 102(e) as being anticipated by Picard et al. US 6,233,318.

4.1 Regarding claim 73, Picard discloses a multi-media messaging system in figures 1-6 (column 3, lines 33-62; column 7, lines 13-19). Picard teaches notifying a recipient of a stored message (column 3, lines 50-51), and based on the header of a message, announcing a sender's name (generating an information signal) in sender's own voice in a voice message, or in a synthesized voice in a text message (relating to the source) to the recipient's communication device (associated with the addressee of the stored message) (column 7, lines 20-23, 29-67; column 8, lines 1-9). Pacard further teaches that audio signals can be sent to the recipient in sound waveform (column 18, lines 35-42).

4.2 Regarding claim 75, Picard teaches announcing a sender's name to a message recipient in a sound waveform. It is inherent the name announcement comprising a plurality of sound waveforms since a name normally includes a first name and a last name.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1, 9-15, 17-20, 34, 48, 56, 62-65, 69, 73 and 74 are rejected under 35 U.S.C. 103(a) as being unpatentable over Greco et al. US 5,568,540 in view of Dawson US 6,252,588.

5.1 Regarding claims 1, 34, 56 and 73, Greco discloses a messaging system in figures 1 and 2. A call processor 38, acting as a server, generates a message list, each entry in the list comprising an information signal associated with the source of a stored message, and transmits said information signal to a client computer 14 [communications device of an addressee] (column 3, lines 63-67) for display as shown in the second and the fifth columns in figure 2 (column 4, lines 45-51 and 57-59). The

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information signal generated by the Greco reference includes the source's name (if the caller is a registered user), telephone number, date and time, and types of the message such as voice, fax and e-mail.

Greco fails to teach including a graphical image in the information signal.

However, Dawson discloses a method and apparatus for providing an audio-visual e-mail system. Dawson teaches selecting a thumbnail picture or a sender (column 20, lines 51-56), replacing ab sender's e-mail address with the thumbnail picture (graphical image), so that the thumbnail picture is displayed on a recipient's communication device to identify the sender immediately without opening the e-mail (Figure 10; column 9, lines 49-52; column 20, lines 56-61; column 30, lines 42-46).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Greco's system with the teaching of Dawson, so that a thumbnail picture of a sender would have been sent with an e-mail to identify a sender, and the thumbnail picture would have been displayed instead of an e-mail address on an recipients communication device, because such a modification would have enabled a recipient to identify a sender immediately.

5.2 Regarding claims 9-11 and 62-64, the Greco reference, modified by Dawson, Greco further teaches determining the source of a message, including a caller's telephone number, name and graphical image (thumbnail picture) (figure 2).

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5.3 Regarding claim 12, as discussed above in claim 1, the Greco reference, modified by Dawson, teaches requesting source information (sender's thumbnail picture) from a sender's communication device, which is also a networked device since it is connected to a network for sending and receiving e-mails, to be sent with an e-mail, and the source information is associate with at least one graphical image (Dawson, column 9, lines 49-52; column 30, lines 42-46).

5.4 Regarding claims 13 and 15, as discussed above in claim 1, the Greco reference, modified by Dawson, teaches receiving e-mails, associated with the source and receive a sender's information including the thumbnail picture.

5.5 Regarding claim 14, the Greco reference, modified by Dawson, teaches storing a message in server 38 and generating an information signal, which also stored in the server 38 as shown in figure 2.

5.6 Regarding claims 17-20, 48 and 65, the Greco reference, modified by Dawson, Greco further teaches determining the media type of a message (text for e-mail) and generating a graphical image embedded the information signal (column 2, lines 19-24; figure 2).

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5.7 Regarding claim 74, the Greco reference, modified by Dawson, teaches including a graphical image in the information signal. It is inherent that one thumbnail picture can include more than one image.

6. Claims 24, 25 and 68 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dawson US 6,252,588 in view of Picard et al. US 6,233,318 and further in view of Koralewski et al. US 5,875,239.

Dawson teaches that when notifying a recipient of a stored e-mail, a sender's email address is replaced with a thumbnail picture of the sender, so that the recipient can recognize who the sender is. Dawson fails to teach including digital representation of a sound waveform associated with the sender (source).

However, Picard teaches that an e-mail envelope information, such as a sender's address, maybe announced to a recipient in a synthesized voice (digital sound wave form) (column 7, lines 29-67, column 8, lines 1-9).

In addition, Koralewski discloses a notification signal for notifying an incoming telephone call. Koralewski teaches generating an visual (caller's graphical image) and audio (caller's presentation) notification signal to alert a called party, so that the called may decide to whether answer the incoming call or not (Abstract; column 3, lines 20-23; column 4, lines 10-14, 18-31).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Dawson's reference with the teaching of Picard and Koralewski, so that a in addition to a thumbnail picture, a digital sound

identifying the sender, would have been included in the information signal. The motivation of the modification was based on a prior art notification signal, which included both visual and audio, since Dawson disclosed visual notification for an e-mail and Picard discloses audio notification for an e-mail, a notification signal for an e-mail, therefore, would have been and visual and audio.

7. Claims 26, 27, 28, 49, 69 and 76 are rejected under 35 U.S.C. 103(a) as being unpatentable over Greco et al. US 5,568,540 in view of Dawson US 6,252,588 and further in view of Kimura et al. US 5,778,054.

7.1 Regarding claims 26, 28, 49 and 69, the Greco reference, modified by Dawson, teaches including a graphical image for replacing as an e-mail address, but fails to teach deriving the graphical image from a video frame from a video stream.

However, Kimura discloses a method and apparatus for displaying images corresponding to an electronic address, such as a telephone number or an e-mail address in figure 5. Kimura teaches adding an image from video information to the directory number so that a person associated with the directory number can be easily identified (column 4, lines 29-49; Figure 6).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to further modify the Greco's system, which was modified by Dawson with the teaching of Kimura so that a thumbnail picture associated with a sender, would have been extracted from a video stream, and the thumbnail picture

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would have replaced an e-mail address and displayed on the recipient's communication device, because such a modification would have enabled a sender to use any available graphical image.

7.2 Regarding claims 27 and 76, the Greco reference, modified by Dawson, teaches including a graphical image for replacing as an e-mail address, but fails to teach deriving the graphical image from a video frame from a video stream, and the video stream is included in the e-mail message.

However, Kimura discloses a method and apparatus for displaying images corresponding to an electronic address, such as a telephone number or an e-mail address in figure 5. Kimura teaches adding an image from video information to the directory number so that a person associated with the directory number can be easily identified (column 4, lines 29-49; Figure 6).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to further modify the Greco's system, which was modified by Dawson with the teaching of Kimura so that thumbnail picture, which inherently may comprise multiple images and associated with a sender, would have been extracted from a video stream, and the thumbnail picture would have replaced an e-mail address and displayed on the recipient's communication device, and it is inherent that the video stream would have been included in an e-mail message, since an e-mail message would have included an attachment, which could be audio or video, because such a modification would have enabled a sender to use any available graphical image.

8. Claims 33 and 72 are rejected under 35 U.S.C. 103(a) as being unpatentable over Greco et al. US 5,568,540 in view of Dawson US 6,252,588 and further in view of Dunn 5,651,054.

The Greco reference, modified by Dawson and Kimura, teaches including a graphical image of the sender of a stored message in the information signal, Greco further teaches that if the client computer is connected to the server 39 via network 30, the information of a voice message from a caller being recorded by the server is forwarded to the client computer (column 3, lines 61-67). Greco fails to teach interrupting the storage of the voice message and connecting the caller with a user at the client computer 14.

However, Dunn discloses a method and apparatus for monitoring a message. Dunn teaches that client computer 14 is alerted when an incoming message is being stored (figure 5, reference numeral 161), and a subscriber may click on the TAKE CALL button to interrupt the storage and be connected to the caller (column 6, lines 20-24).

Since the Dunn's system is similar to Greco's, therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to further modify the Greco's reference, which was modified by Dawson with the teaching of Dunn, so that a message status would have been included in the message list and a TAKE CALL function would have been added, because such a modification would have enabled a subscriber to screen an incoming voice message, and to answer the call if he or she so desired.

Allowable Subject Matter

Examiner apologized for quoting a wrong paragraph for allowance in the previous action.

9. Claims 3, 4, 24, 25, 29, 30, 35, 47, 55, 58, 59, 68, 70 and 77 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following are statements of reasons for the indication of allowable subject matter:

9.1 Claims 3, 4, 35, 55, 58 and 59 disclose a method for identifying a network location where at least one graphical image associated with the source of a stored message can be accessed by a message recipient, and including the network location in an information (notification) signal transmitted to the recipient for indicating the receipt of the stored message. This method is not taught by Dawson, Greco and Kimura, either alone or in combination.

9.2 Claim 77 disclose a method for including a graphical image and a sound waveform, both associated with the source of a stored message and captured from a video stream included in the stored message, in an information (notification) signal, and

transmitting the information signal to a recipient. This method is not taught by Dawson, Greco and Kimura, either alone or in combination.

9.3 Claims 29, 30, 47 and 70 disclose a method for adding at least a portion of an information signal (indicating receipt of a stored message) to a web page accessible by an message recipient. This method is not taught by Dawson, Greco and Kimura, either alone or in combination.

Response to Arguments

10. Applicant's arguments filed on 02/05/2004 have been fully considered but they are not persuasive.

107.1 Claims 1, 34, 56 and 73 over Dawson: The applicants argue that Dawson does not teach generating an information signal, because the thumbnail picture of Dawson is added to a header of an e-mail message and then send to a recipient. The applicant also argues that the thumbnail picture does relate to stored message, so that Dawson does not teach notification of a stored message.

However, Dawson discloses sending message senders' thumbnail pictures to a recipient as shown in Figure 10 to indicate receipt of stored messages [e-mail] waiting for retrieval. Dawson teaches replacing an e-mail address of a sender with the thumbnail picture, so that the sender can be easily identified by a recipient (column 9, lines 49-52; column 36, lines 42-46). In an e-mail system, a header is part of an e-mail message, including a sender's address, a recipient's address, subject, time and other

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attributes (in this case, including a thumbnail picture). Dawson teaches adding a thumbnail picture to the header, and for an e-mail server to send the thumbnail picture to a recipient, the thumbnail picture is extracted from the header. Extracting the thumbnail picture is generating the information signal, because the thumbnail picture itself is the information signal. As shown in figure 10, each thumbnail picture is a notification (information) signal, indicating of stored e-mail messages waiting for retrieval.

The Applicant also argues that a recipient's computer does not fulfilled claim language of a communication device, since a communication device includes other than a computer. However, since the Applicant claims a communication device (no specific types or devices are claimed) and a computer is a communication device, therefore reads on the claim language.

10.2 Claims 1, 34, 56 and 73 over Greco in view of Dawson. Sa stated above, Dawson teaches generating a graphical notification signal for replacing an e-mail address.

10.3 Claim 73 over Picard: The applicants argue that Picard does not teach the full limitation of claim 73. However, claim 73 states: "... at least one of (limitation) A and (limitation) B". Examiner interprets either A or B alone reads on this claim. Picard teaches announcing a message sender's name (either in sender's own voice, or in a

synthesized voice) to a message recipient, is an information signal for notifying the recipient that a message has been received and stored.

Conclusion

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

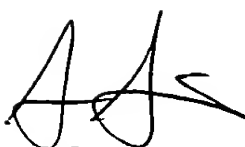
12. Any inquiry concerning this communication or earlier communication from the examiner should be directed to Simon Sing whose telephone number is (703) 305-3221. The examiner can normally be reached on Monday - Friday from 8:30 AM to 5:30 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang, can be reached at (703) 305-4895. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

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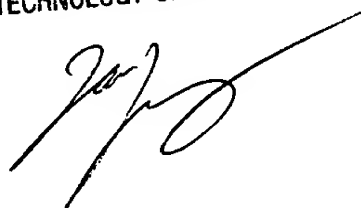
Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4750.

A handwritten signature in black ink, appearing to be 'S.S.' with a stylized flourish.

S.S.

05/03/2004

FAN TSANG
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600

A handwritten signature in black ink, appearing to be 'Fan Tsang' with a stylized flourish.